

### **REMARKS**

This Amendment is in response to the Office Action mailed November 26, 2008. Claims 1, 4, 5, 8-13, 16, 17, 20-25, 28, 29, 32-36 and 44-52 are pending. In this response, claims 1, 13, 25, 45, and 49 have been amended. No claims have been added or cancelled. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

#### ***Rejection Under 35 U.S.C. § 112***

The Examiner rejects claims 1, 4, 5, 8-13, 16, 17, 20-25, 28, 29, 32-36 and 44-52 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants have accordingly amended claims 1, 13, and 25. It is respectfully submitted that the claims are properly supported by the specification. Thus, Applicants respectfully request withdrawal of the rejection of claims 1, 4, 5, 8-13, 16, 17, 20-25, 28, 29, 32-36 and 44-52 under 35 U.S.C. § 112, first paragraph.

The Examiner rejects claims 1, 4, 5, 8-13, 16, 17, 20-25, 28, 29, 32-36 and 44-52 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants have accordingly amended claims 1, 13, and 25 to precisely claim that which the Applicants regard as their invention. Thus, Applicants respectfully request withdrawal of the rejection of claims 1, 4, 5, 8-13, 16, 17, 20-25, 28, 29, 32-36 and 44-52 under 35 U.S.C. § 112, second paragraph.

#### ***Rejection Under 35 U.S.C. § 103***

The Examiner rejects claims 1, 4, 8, 13, 16, 20, 25, 28, 32, and 44-52 under 35 U.S.C. § 103(a) as being unpatentable over Morris et al.(U.S. Patent 5,420,974, hereinafter "Morris") in view of Hoda et al. (U.S. Patent 4,831,610, hereinafter "Hoda"). Applicants respectfully disagree.

Morris describes a document that is divided into two types of fields. A first field type of the document displays text and images, and a second field type of the document displays check boxes (Morris, column 1, line 58 to column 2, line 9). When a check box field is checked, non-visual content (audio, video, or animation not displayed in the document) for the document is available. During creation of a document, if a checked box for a second field type is selected by a user, a dialog box prompts the user to specify an address for the audio or video content (Morris, column 2, line 61 to column 3, line 4). A pointer is created for the content so that when a user selects a checked box in a document, the content may be accessed from storage via the pointer (Morris, column 3, lines 4-27).

Hoda describes a visual data playback system and apparatus for a video disk player (Hoda, Figure 1; Abstract). A barcode is printed on a medium, and when scanned, causes the system of Hoda to access media content stored on a digital video disk. The video disk player then plays the accessed video or audio content from the digital video disk (Hoda, Column 2, lines 24-52).

Amended claim 1 recites:

A method comprising:  
creating a multimedia annotation for a paper document, the multimedia annotation representing at least one of an audio sound and a video clip; and  
creating a first multimedia document by combining the paper document and the multimedia annotation represented by a first bar code encoding the at least one of the audio sound and video clip,  
wherein the first multimedia document is generated in response to a user-initiated copy request to reproduce the paper document via a document reproduction system, wherein the multimedia annotation is captured via a microphone of an input device of the document reproduction system while the paper document is being reproduced via the document reproduction system, wherein the captured multimedia annotation is digitized by the document reproduction system and encoded within the first bar code, and  
wherein the first multimedia document, which when scanned by a process, the process causes the printed multimedia annotation to be decoded, the at least

one of the audio sound and video clip to be extracted from the multimedia annotation, and the at least one extracted audio sound and video clip can be played via a multimedia player.

(Emphasis Added)

That is, in accordance with claim 1, a multimedia annotation for a paper document is created which represents at least one of an audio and video clip. A multimedia document is then created by combining the paper document and the multimedia annotation. Furthermore, the multimedia annotation is captured via an input device of a document reproduction system in response to a user-initiated request to reproduce the paper document. The multimedia annotation is captured via a microphone of the document reproduction system when the user reproduces the paper document, wherein the captured audio sound is part of the multimedia annotation embedded within the first bar code. The multimedia document includes the bar code encoding the audio sound and video clip which can be subsequently scanned and decoded to extract the audio sound and video clip from the barcode. The audio sound and video clip extracted and decoded from the barcode can then be played by a multimedia player.

Applicants respectfully submit that a combination of Morris and Hoda fail to describe or suggest "wherein the first multimedia document is generated in response to a user-initiated copy request to reproduce the paper document via a document reproduction system, wherein the multimedia annotation is captured via a microphone of an input device of the document reproduction system while the paper document is being reproduced via the document reproduction system, wherein the captured multimedia annotation is digitized by the document reproduction system and encoded within the first bar code," as claimed. In other words, and in accordance with the claims, neither Morris nor Hoda describes or suggests reproduction of a

paper document and automatically initiating the capture of user supplied audio content via a microphone of the reproduction system for an audio multimedia annotation.

Applicants claim in part "the first multimedia document is generated in response to a user-initiated copy request to reproduce the paper document via a document reproduction system, wherein the multimedia annotation is captured via a microphone of an input device of the document reproduction system while the paper document is being reproduced via the document reproduction system" (Emphasis Added). Morris describes a process for scanning a form, and storing the form with its contents as a specialized mixed object document content architecture (MODCA) data type (Morris, Abstract; Column 2, lines 10-27). In Morris, a user first defines a form's properties and locations for the contents of the form which defines MODCA type for the form. Then, when the form is scanned as part of a media storage/archiving operation, the MODCA type for the form is determined, and content is extracted from the form for storage. For content that may not be displayed directly on a form (e.g., video, sound recordings, etc.), a dialog box is displayed during the scan-in process, which prompts a user "to enter the media address for the object" (Morris, column 2, lines 63-65). Thus, Morris requires a user to specify a media address for an existing media object during a form storage operation. Applicants, however, claim a user-initiated copy request where the multimedia annotation is captured via a microphone of an input device of the document reproduction system. The storage/archiving system for MODCA documents in Morris fails to describe a document reproduction system that generates multimedia documents (i.e., "combining the paper document and the multimedia annotation") in response to user-initiated copy requests. Furthermore, Morris merely describes allowing users to enter media addresses for voice, video, etc. files during a storage/archiving

process, and not capturing a multimedia annotation via a microphone while a document is being reproduced.

Hoda describes accessing a video disk for video or audio content associated with a barcode (Hoda, Abstract; column 2, lines 24-52). There is no hint or suggestion within Hoda that a multimedia document is created in response to a user-initiated copy request where the multimedia annotation is captured via a microphone of an input device of the document reproduction system, or that the multimedia annotation is captured while the document is being reproduced, as claimed. Thus, Hoda fails to remedy the shortcomings of Morris discussed above.

Therefore, a combination of Morris and Hoda fail to describe or suggest "the first multimedia document is generated in response to a user-initiated copy request to reproduce the paper document via a document reproduction system, wherein the multimedia annotation is captured via a microphone of an input device of the document reproduction system while the paper document is being reproduced via the document reproduction system," as claimed.

Applicants further claim in part "the captured multimedia annotation is digitized by the document reproduction system and encoded within the first bar code." As discussed above, Morris merely describes users specifying storage locations for existing media content (Morris, column 2, lines 63-65). Furthermore, Hoda describes accessing media content, associated with a barcode, that has been pre-stored on a digital video disk (Hoda, column 2, lines 24-52). Thus, in both Morris and Hoda, the media content already exists, and neither would be required to digitize captured content. Because Morris and Hoda describe specifying addresses of and accessing existing media content, the combination of Morris and Hoda also fails to describe or suggest that a multimedia annotation, which was captured via a microphone of a document reproduction

system, is "digitized by the document reproduction system and encoded within the first bar code," as claimed.

Therefore, Applicants respectfully submit that a combination of Morris and Hoda fails to describe or suggest "the first multimedia document is generated in response to a user-initiated copy request to reproduce the paper document via a document reproduction system, wherein the multimedia annotation is captured via a microphone of an input device of the document reproduction system while the paper document is being reproduced via the document reproduction system, wherein the captured multimedia annotation is digitized by the document reproduction system and encoded within the first bar code," as claimed.

Because claims 13 and 25 include limitations similar to those discussed above with respect to claim 1, claims 13 and 25 are similarly not anticipated by Morris and Hoda. Given the remaining claims depend from one of the above independent claims, for reasons similar to those set forth above, it is respectfully submitted that the rest of the claims are also patentable over a combination of Morris and Hoda.

Applicant respectfully requests that the Examiner withdraw the rejections of claims 1, 4, 8, 13, 16, 20, 25, 28, 32, and 44-52 under 35 U.S.C. § 103(a) as being unpatentable over Morris, in view of Hoda.

With respect to claim 45, the present invention as claimed requires "capturing an audio sound of the multimedia annotation from a user who speaks into a microphone of the input device when the user reproduces the paper document using the document reproduction system, wherein the captured audio sound is part of the multimedia annotation embedded within the first bar code." Applicants respectfully submit that this is not shown in Morris or Hoda. The Examiner cites Morris at column 2, lines 5-20 and column 3, lines 10-15), and states that Morris

describes audio and video records and steps that allow a user to add new recorded segments of audio, video, etc. (Office Action, mailed 11/26/08, pages 16-17). Applicants respectfully disagree. Morris describes that boxes on a MODCA form may represent different data types, such as audio or video data (Morris, column 2, lines 5-20, and that new objects may be associated with the MODCA envelope for the form (Morris, column 3, lines 10-15). However, as explicitly recited in Morris, a dialog box is presented to a user "to enter the media address for the object" (Morris, column 2, lines 63-65). Merely specifying a storage location for a media content object, however, completely fails to describe or suggest "capturing an audio sound of the multimedia annotation from a user who speaks into a microphone ... when the user reproduces the paper document using the document reproduction system." Hoda merely describes barcodes associated with content stored on a digital video disk, and thus fails to remedy the shortcomings of Morris. In view of this, Applicants respectfully submit that the present invention as claimed in claim 45, is not obvious over a combination of Morris and Hoda.

With respect to claim 49, the present invention as claimed requires "in response to a request to retrieve a multimedia document from among the plurality of multimedia documents stored in the storage, performing a content-based search on multimedia annotations of the plurality of multimedia documents for the requested multimedia document within the storage based on content of the multimedia annotation associated with the requested multimedia document." Applicants respectfully submit that this is not shown in Morris or Hoda. The Examiner cites Morris at column 3, lines 35-45, and states that a MODCA envelope is accessed to obtain content when a checkbox in a MODCA-based form is scanned (Office Action, mailed 11/26/2008, page 19). There is nothing within the passage of Morris relied upon by the examiner, as well as the remainder of Morris, that describes or even suggests "a content-based search on

multimedia annotations." Rather, Morris describes the opposite of a content-based search of multimedia annotations based on content of a multimedia annotation, since Morris describes explicitly defining media content storage locations (*See* Morris, column 2, lines 63-65). Hoda similarly describes accessing media content on a digital video disk identified by a barcode, but fails to describe performing content-base searches of any kind. In view of this, Applicants respectfully submit that the present invention as claimed in claim 49, is not obvious over a combination of Morris and Hoda.

The Examiner rejects claims 5, 9-11, 17, 21-23, 29, and 33-35 under 35 U.S.C. § 103(a) as being unpatentable over Morris, in view of Hoda, and further in view of Schena et al. (U.S. Patent 6,448,979, hereinafter "Schena"). Applicants respectfully disagree.

Claims 5, 9-11, 17, 21-23, 29, and 33-35 depend from one of the above independent claims. It is respectfully submitted that Schena also fails to disclose the limitations set forth above. Therefore, for reasons similar to those set forth above, it is respectfully submitted that claims 5, 9-11, 17, 21-23, 29, and 33-35 are also patentable over a combination of Morris, Hoda, and Schena. Withdrawal of the rejections is respectfully requested.

The Examiner rejects claims 12, 24 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Morris, in view of Hoda, further in view of Schena, and further in view of Halliday et al. (U.S. Patent 5,880,740, hereinafter "Halliday"). Applicants respectfully disagree. Claims 12, 24, and 36 depend from one of the above independent claims. It is respectfully submitted that Halliday also fails to disclose the limitations set forth above. Therefore, for reasons similar to those set forth above, it is respectfully submitted that claims 12, 24, and 36 are also patentable over a combination of Morris, Hoda, Schena, and Halliday. Withdrawal of the rejections is respectfully requested.



***Conclusion***

Applicants reserve all rights with respect to the applicability of the doctrine of equivalents. Applicants respectfully request that a timely Notice of Allowance be issued in this case. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300.

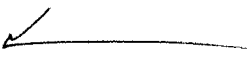
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Respectfully submitted,

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By

  
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